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| 09/311,753      | 05/14/1999  | TSUYOSHI INOUE       | Q54370              | 1662             |

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06/24/2003

SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 PENNSYLVANIA AVENUE N W  
WASHINGTON, DC 20037

EXAMINER

BERNATZ, KEVIN M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1773

DATE MAILED: 06/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

AS-29

# Office Action Summary

Applicati n N .

09/311,753

Applicant(s)

INOUE ET AL.

Examin r

Kevin M Bernatz

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-- The MAILING DATE of this communication appears n the cover sh et with the c rrespondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2 and 3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 and 3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### ***Response to Submission***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

2. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyahara et al. ('751 A) in view of the general state of the art as taught by any one of Arakawa et al. (JP '528 A), Müssig ('353 B1) or Matsui et al. (EP '354 A2). See provided Abstract translations and Machine translations of JP '751 A and JP '528 A.

Regarding claim 2, Miyahara et al. disclose a sheet which comprises a support comprising a polymer film (*Figure 1, layer 1b*) laminated on one or both surfaces of a non-woven fabric (*layer 1a*), and a pressure-sensitive adhesive layer formed on one surface of said polymer film opposed to the polymer film surface adhered to the non-woven fabric (*layer 2*), wherein said non-woven fabric has a basis weight of 5 to 100 g/m<sup>2</sup> (*Paragraph 0011 and Table – 70 g/m<sup>2</sup>*) and said polymer film comprises a thermoplastic polymer (*JPO Abstract and Constitution; Figure 1; Machine Translation paragraphs 0007 – 0013 and 0019*). Miyahara et al. further disclose that the film can be used to adhere and protect metallic surfaces from corrosion due to water (*Abstract and Paragraph 0017*).

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Miyahara et al. fail to disclose a method of protecting paint films of automobiles using the disclosed sheet.

However, Arakawa et al., Müssig and Matsui et al. all teach that it is old in the art to use thermoplastic films with a pressure sensitive adhesive layer as a method of protecting paint films of automobiles from debris, dirt, etc. during transport and delivery (*Arakawa et al. – Abstract & Machine Translation Paragraphs 0001 – 0003; Müssig – col. 1, lines 1 – 40; col. 2, lines 29 – 33; col. 3, lines 35 – 40; and col. 6, line 55 bridging col. 7, line 8; Matsui et al., page 2, lines 12 – 21*). The Examiner notes that automobiles comprise metallic surfaces.

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Miyahara et al. to be used as a method of protecting a paint film of an automobile from debris and dirt as taught by Arakawa et al., Müssig and Matsui et al., since it is taught that it is known in the art to use plastic films with pressure sensitive adhesive coatings as protective films for automobile paint, and the Miyahara et al. invention would not only protect the paint films from debris and dirt, but would also protect any exposed metallic portions from corrosion due to water, etc.

Regarding claim 3, Miyahara et al. disclose a polymer film meeting applicants' claimed limitations (*Machine Translation paragraphs 0013 and 0019 and Examples 2 and 3 in Table 1*).

3. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seth ('964) in view of the general state of the art as taught by any one of Arakawa et al. ('528 A), Müssig ('353 B1) or Matsui et al. ('354 A2). See provided Abstract translations and Machine translations of JP '751 A and JP '528 A.

Regarding claim 2, Seth discloses a sheet which comprises a support comprising a polymer film (*Figure 3, layer 16 and col. 5, lines 7 - 37*) laminated on one or both surfaces of a non-woven fabric (*layer 14*), and a pressure-sensitive adhesive layer formed on one surface of said polymer film (*layer 18*) opposed to the polymer film surface adhered to the non-woven fabric, wherein said non-woven fabric has a basis weight of 5 to 100 g/m<sup>2</sup> (*col. 2, lines 54 – 59*) and said polymer film comprises a thermoplastic polymer (*col. 5, lines 7 – 25 and col. 6, lines 35 – 64*).

While Seth teaches a preferred structure to prevent excessive removal of the non-woven fibers when the adhesive tape is removed from a roll (*col. 2, lines 60 – 65*) Seth fails to disclose a method of protecting paint films of automobiles using the disclosed sheet.

However, Arakawa et al., Müssig and Matsui et al. all teach that it is old in the art to use thermoplastic films with a pressure sensitive adhesive layer as a method of protecting paint films of automobiles from debris, dirt, etc. during transport and delivery (*Arakawa et al. – Abstract & Machine Translation Paragraphs 0001 – 0003; Müssig – col. 1, lines 1 – 40; col. 2, lines 29 – 33; col. 3, lines 35 – 40; and col. 6, line 55 bridging col. 7, line 8; Matsui et al., page 2, lines 12 – 21*).

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Seth to be used as a method of protecting a paint film of an automobile from debris and dirt as taught by Arakawa et al., Müssig and Matsui et al., since it is taught that it is known in the art to use plastic films with pressure sensitive adhesive coatings as protective films for automobile paint and using the film taught by Seth would allow the adhesive tape to be removed from its roll without excessive removal of the non-woven fibers.

Regarding claim 3, Seth further disclose a range in thickness overlapping applicants' claimed limitation. While Seth fails to disclose an embodiment meeting applicants' claimed limitations, it would have been obvious to one having ordinary skill in the art to have determined the optimum value of a cause effective variable such as the thickness of the polypropylene backing layer through routine experimentation in the absence of a showing of criticality in the claimed thickness, especially given the teaching in Seth regarding the overlapping range in thickness and the knowledge that the thickness of the film will effect the pliability and strength of the adhesive tape. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

***Response to Arguments***

**4. The rejection of claims 2 and 3 under 35 U.S.C § 103(a) – Miyahara et al. in view of Arakawa et al., Müssig and Matsui et al.**

**5. The rejection of claims 2 and 3 under 35 U.S.C § 103(a) – Seth in view of Arakawa et al., Müssig and Matsui et al.**

Applicant(s) argue(s) that that the combination of either Miyahara et al. or Seth with Arakawa et al., Müssig and Matsui et al. is improper because neither Miyahara et al. nor Seth are analogous with the Arakawa et al., Müssig and Matsui et al. references. The examiner respectfully disagrees.

The Examiner notes that Miyahara et al. teach an adhesive tape for use on metallic surfaces to provide good corrosion resistance. Automobiles have metallic surfaces and must be protected from corrosion, therefore, the Examiner deems that the field of endeavor between Miyahara et al. and Arakawa et al., Müssig and Matsui et al. would be analogous.

Regarding Seth, the Examiner notes that Seth is directed to the generic properties of any adhesive film coming off a roll. Arakawa et al., Müssig and Matsui et al. all rely upon adhesive films for protecting the paint films of automobiles and the majority of adhesive tapes are known in the art to be provided in roll form (*see any convenient store's tape section*). Therefore, the Examiner deems that one of ordinary skill in the art looking to improve adhesive tapes for whatever purpose would turn to the teachings in Seth since one of ordinary skill in the art would seek to avoid any problems with the removal of the tape from its roll. As such, the Examiner deems that the

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teachings of Seth are within the same field of endeavor as the Arakawa et al., Müssig and Matsui et al. inventions.

Applicants further argue the specifics of the combinations between Miyahara et al. or Seth and each of the Arakawa et al., Müssig and Matsui et al. references. The Examiner acknowledges applicants' arguments, but notes that they are moot since Arakawa et al., Müssig and Matsui et al. are merely cited to teach the general state of the art and that one of ordinary skill in the art would recognize that pressure sensitive adhesive tapes can be used to protect the paint films of automobiles.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (703) 308-1737. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703) 308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



KMB  
June 20, 2003



Paul Thibodeau  
Supervisory Patent Examiner  
Technology Center 1700